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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,534	10/12/2006	Jean-Marie Gouot	P/3610-75	9946
2352 7590 09/11/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER SULLIVAN, DANIELLE D	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 09/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,534	Applicant(s) GOUOT ET AL.	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/27/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments and arguments filed 05/27/2008 are acknowledged and have been fully considered. Claims 1-16 remain pending. Claims 1-16 have been amended.

Withdrawn rejections

Any rejection and/or objection not specifically addressed below are herein withdrawn.

Response to Arguments

Applicant's arguments, with respect to the rejection(s) of claim(s) 1-16 under USC 102(e) and USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of applicant's amendments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al. (US 2005/0234110) in view of Brandes et al. (5,532,262).

Applicant's Invention

Applicant claims a fungicidal composition comprising a) a pyridylethylbenzamide derivative of formula (I) and b) a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivatives thiopantate, thiopantate-methyl and diethofencarb. Claim 2 and 3 specify the p and q in formula I), respectively, is 2. Claim 4-7 specify X and Y in formula I), respectively are selected from halogen and haloalkyl, preferably, chlorine or trifluoromethyl. Claim 8 and 9 specify formula I) is N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. Claim 10 and 11 specify b) is a benzimidazole derivative, preferably selected from benomyl, carbendazim and thiabendazole. Claim 12 specify b) is selected from diethofencarb. Claim 13 and 14 specify and addition fungicide, preferably selected from iprodione and chlorotalonil. Claim 15 specify the composition comprises a support, carrier, filler and/or surfactant.

Applicants also claim a method of controlling phytopathogenic fungi in crops by applying the composition to the seed, plant, fruit or soil.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Mansfield et al. teaches the pyridylethylbenzamide derivative of formula (I) with the preferably structure being N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide [0005]-[0011], [0020] and [0027]. The compound may comprise a support, carrier or filler [0045]. The compound may include surfactants [0047]. The compound may be mixed with one or more insecticides, fungicides,

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bactericides, etc. [0052]. The composition is used to control phytopathogenic fungi in crops by application to the seed, plant, fruit or soil [0053].

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Mansfield et al. does not teach the additional fungicides include a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivatives thiopantate, thiopantate-methyl and diethofencarb and the addition fungicide selected from iprodione and chlorotalonil. It is for this reason that Brandes et al. is joined.

Brandes et al. teaches fungicidal compositions useful for the control of phytopathogenic fungi (column 1, lines 1-17). The compounds carbendazim, diethofencarb, iprodione, thiopantate, thiopantate-methyl and benomyl are taught display very good fungicidal properties (column 3, line 20-25; column 4, lines 50-65; column 6, lines 19-35)

It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art.” In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980). Thus, combining carbendazim, diethofencarb, iprodione, thiopantate, thiopantate-methyl and benomyl with N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, as claimed in the instant invention, sets forth prima facie obvious subject matter.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Mansfield et al. and Brandes et al. to utilize a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivatives thiopante, thiopante-methyl and diethofencarb and the addition fungicide iprodione. One would have been motivated to utilize these compounds because Brandes et al. teaches that they are known to display fungicidal properties when combined in combination with other fungicides to be effective on pathogenic fungi.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Mina Haghighatian/
Primary Examiner, Art Unit 1616